

### **Remarks**

In the present Office Action, the Examiner rejected claims 37 through 41 under 35 U.S.C. 102(b) as being anticipated by Buske (US 3,524,782, hereinafter the '782 patent). The Examiner further rejected claims 2 through 16, 18 through 22 and 42 under 35 U.S.C. 103(a) as being unpatentable over the '782 patent in view of Konkol et al (US 5,735,549). The Examiner rejected claim 17 under 35 U.S.C. 103(a) as being unpatentable over the '782 patent in view of Konkol et al and Franklin (US 5,255,456), while claims 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '782 patent in view of Horton-Steidle et al (US 6,167,679, hereinafter the '679 patent). Furthermore, the Examiner rejected claims 30, 33, 35, 36 and 43 as being unpatentable over the '782 patent, while claim 34 was rejected as being unpatentable over the '782 patent in view of the '679 patent.

On pages 8 through 9, 11 through 12 and 18 through 19 of the Office Action, the Examiner takes the position that the printed matter required of the claims of the present invention is not functionally related to the substrate (especially, that the printed matter "does not act in combination with the structure on which it is printed"), and as such is not entitled to patentable weight. The Examiner cites *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983) in support of his position that "when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability." The Examiner further relies upon *In re Miller*, 164 USPQ 46 (CCPA 1969) that indicia placed upon a substrate must act in combination with the structure on which it is printed to establish a functional relationship between them. In the *Gulack* case, the court found that a functional relationship existed in a band that supports digits printed thereon for the purpose of performing mathematical tricks, and that there is an endless sequence of such digits with each digit in a unique position with respect to every other digit in an endless loop of the band. In the *Miller* case, the court found that measuring indicia placed on a measuring cup established the necessary functional relationship between the indicia and the receptacle. *Miller*, 164 USPQ at 48. The *Miller*

court took great pains to emphasize that in a combination claim, printed matter should not be ignored, even if the indicia itself was not patentable subject matter. *Id.* at 48-49.

By the present response, the Applicant submits that the claims of the present application, which includes both a positive recitation of the nature of the printed indicia, in addition to cooperation between the two types of indicia, shipping label and packing list and the substrate to which such indicia are applied, analogize the facts of *Gulack* and *Miller*, and as such are entitled to a similar holding. The printed indicia imparts patentability to the claims by virtue of the cooperation of the words contained in the printed indicia to the particular shipping label or packing list to which they are written on. Specifically, the shipping label specifies addresses and related shipping instructions and destination information, while the packing list specifies contents such as pricing and related information. The indicia related to the shipping label is placed on a form first ply such that upon affixing the form to a package, the shipping label indicia is visible to one looking at the package, while the indicia related to the packing list is placed on both the form first ply and a form second ply such that the indicia on the two packing list surfaces are oppositely-facing, with one facing the same direction as the shipping label indicia such that it too is visible to one looking at the package, while the other is generally hidden from view.

The Applicant respectfully submits that by properly construing all of the language used in the claims, the Examiner must come to the conclusion that the cited art is no longer relevant. Stated another way, the Examiner must consider all words in the claim to assess patentability of the claimed device. See, e.g., *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)). This bedrock principle holds whether the rejection is based on anticipation or obviousness. *In re Miller*, 169 USPQ 597, 600 (CCPA 1971). The clear recitations in the amended independent claims avoid the '782 patent, which teaches a protection label over a coupon. At most, the '782 patent teaches a continuous web of a single type of label (specifically, a coupon) repeated along the length of the web. In contrast, the packing list of claim 37 and the first label of claims 42 and 43 include multiple layers bonded to one another with one of the opposing-sides of these layers

including variable printed indicia thereon, while the other side is printed only with pre-printed indicia, while the shipping label of claim 37 and second label of claims 42 and 43 is applied as a single ply label when affixed to an object. In addition, the shipping label (or second label) is contiguous with the packing list (or first label), and is variably imaged with address indicia on its first ply front at the same time the packing list first ply front is variably imaged. The '782 patent lacks a teaching where such contiguous placement and variable imaging, as well as differently configured layer construction, adhesive layers, release layers and lines of weakness of each are separately recited.

Referring with particularity to independent claim 37, the preamble unequivocally recites that the claimed device is a form that is a combination of a packing list and a shipping label. This is bolstered in the body of the claim, where a detailed recitation of the construction of the packing list is followed by a detailed recitation of the construction of the shipping label. An important exception to the general rule that the language of the preamble is not entitled to patentable weight is when the preamble provides an antecedent basis to recitations in the claim body. For example, when "limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." *Eaton Corp. v. Rockwell Int'l Corp.*, 66 USPQ2d 1271 (Fed. Cir. 2003). Moreover, a "preamble usually does not limit the scope of the claim unless the preamble provides antecedents for ensuing claim terms and limits the claim accordingly." *C.R. Bard, Inc. v. M3 Sys., Inc.*, 48 USPQ2d 1225 (Fed. Cir. 1998). See also MPEP 2111.02. In the present claims (of which independent claim 37 is an example), the preamble clearly provides antecedent basis for the subsequent recitation in the body that it is the combination of the packing list and shipping label together that define the invention, and as such is entitled to patentable weight. In addition, the Applicant's use of a combination of packing list and shipping in the preamble in conjunction with their subsequent recitation in the claim body makes clear that such a combination is that which is sought to be patented. When "the claim drafter chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent

protects.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 34 USPQ2d 1816 (Fed. Cir. 1995).

The Examiner appears to recognize in the first full paragraph of page 18 of the present Office Action that the claimed device includes a packing list and shipping label. In addition, the Examiner candidly admits that the device taught in the '782 patent does not teach such a combination. In spite of this, the Examiner then goes on to state that the '782 patent teaches structure capable of performing the recited function. This is speculation that he cannot, without some suggestion in the cited art, engage in, for a key component to establishing a *prima facie* case of obviousness is that there must be some motivation to combine the references. MPEP 2143.01.

It is only by ignoring the clear recitations in the claims that the Examiner can maintain that the '782 patent is capable of performing as a combination shipping label and packing list form. In fact, there is nothing to suggest that the '782 patent, which teaches a protection label over a coupon, neither of which are recognized as being the equivalent of a shipping label, even remotely suggests the shipping label aspects of the claimed device. Specifically, the written indicia on the protection label of the '782 patent is clearly pre-printed, leaving no room for variably imaging the address that is the *sine qua non* of a shipping label. Since the device of the '782 patent is not (and could not) be adapted to be an address label, it would not have provided the necessary motivation to one skilled in the art to modify it to come up with the claimed device. Such shortcomings preclude the Examiner from presenting a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious. *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). A rejection based on '103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. *In re Warner*, 154 USPQ 173, 178 (CCPA 1967). The Examiner may *not*, because he may doubt that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in his required factual basis. *Id.* In the present case, one of ordinary skill in the art would not look to the '782 patent to teach a shipping label, and especially not a label set

comprising both a shipping label and a packing list that are formed together on a common adhesive form. At most, the '782 patent teaches a continuous web of a single type of label (specifically, a coupon) repeated along the length of the web.

Further distinctions abound. For example, claims 42 and 43 additionally recite how the printed indicia of the first and second labels differ when their respective labels are adhered to a package or related object, reciting with particularity that information contained within the first label faces the object to which the label is attached, while the information contained within the second label faces away from the object. Even more particularly, independent claim 42 recites that two labels are defined in a common form such that together the labels on the form make up a label set, shown in numerous figures, one example of which is depicted in original FIG. 6. One of the labels includes two printable regions on opposite sides of a stack of multiple plies; this label includes adhesive and release layer portions that cooperate with one another and a line of weakness that circumscribe the printable regions such that the label can be removed from the form and affixed to an object through exposed peripheral adhesive that remains with a second of the label's plies. The other label includes a printable region on the same outer surface of a first ply that is used for the first label, although in a different location on that surface. As with the first label, this second label includes adhesive and release layer portions that cooperate with one another such that the label can be removed and subsequently affixed to an object through exposed adhesive that remains with the first ply. In the first label, the adhesive forms a bond with the inner surface of the second ply, while in the second label, the adhesive forms a bond with the inner surface of the first ply. Thus, when the form is oriented on a planar surface (such as a table top) with the printable region of the second label and the first printable region of the first label face-up and the two labels removed and kept in the form's original orientation, the exposed adhesive from the first label would be face-up, while the exposed adhesive from the second label would be face-down.

In independent claim 43, the first label includes two opposed printable surfaces and has a peripheral adhesive layer. Thus, even upon removal of the first label from the

form, a portion of the adhesive layer **130** remains with and surrounds the first label (thereby acting as a picture frame-like adhesive border); this remaining adhesive layer allows the label to be subsequently affixed to (first ply down) a box, container or related object. There is nothing in the '782 patent that includes the recited feature. While FIG. 10 does show an adhesive layer **23** surrounding a label **25** (or, in the alternative, label **28**), such adhesive does not form a part of the first label and does not remain in contact with the second ply **22**. In fact, what adhesive **23** that does remain with the second ply **22** is not capable of affixing the first label to an object, as such remaining adhesive **23** and second ply **22** have become scrap upon such removal, as clearly indicated at column 2, line 71 of the '782 patent.

Taken *in toto*, it is clear that the cooperation of the printed indicia, as well as the particular structural recitation of the combination form of amended claims 37, 42 and 43 are neither taught nor suggested by the '782 patent, and as such are entitled to a finding of patentability by the Examiner. Upon properly considering the totality of the claims and the particular relationship of each of the distinct labels to the whole, the Applicant respectfully submits that the Examiner must conclude that the independent claims are entitled to a finding of patentability by the Examiner. Furthermore, since all of the dependent claims place additional limitations on the independent claims from which they depend, the Applicant submits that they too are allowable over the cited art. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response.

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Respectfully submitted,

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